IN THE HIGH COURT OF JUDICATURE AT BOMBAY
ORDINARY ORIGINAL CIVIL JURISDICTION

NOTICE OF MOTION NO. 2400 OF 2003.
IN
SUIT NO. 2545 OF 2003

1.Franco-Indian Pharmaceuticals Pvt.Ltd] .. Plaintiff

Versus

1.M/s.East West Pharma & Anr.] .. Defendants

Mr.M.P. Mhadgut for plaintiff.

None for defendant.

CORAM: ANOOP V. MOHTA, J.

DATED: 14TH SEPTEMBER, 2005

P.C. :

1. Plaintiffs have been carrying on a business of manufacture and sale of a medicinal and pharmaceutical preparations in India since long. Plaintiff No.1 - an old company of National and International repute having its registered office in Mumbai. They carry on business as manufacturers, dealers and exporters of such preparations. Plaintiff No.2 is the registered user of plaintiff No.1's trademark "GLYCIPHAGE" which they manufacture with the assistance and guidance of plaintiff No.1, in Mumbai. Defendant Nos.1 and 2 are carrying on business of manufacture and sale of

pharmaceutical and medicinal preparations at Chennai. Plaintiff No.1 had applied for and obtained registration of trademark "GLYCIPHAGE" under No.204551 under the Trade and Merchandise Marks Act, 1958 (for short "Trademarks Act, 1958") on 4th September, 1961. The said trademark has been renewed from time to time and its registration is valid and subsisting. By virtue of an assignment from one M/s.Laboratories Griffon Private Limited, plaintiff No.1 is the present proprietor of the trademark GLYCIPHAGE and the owner of copyright subsisting in the packaging for the product in question.

2. In or about April 2003, plaintiffs came across defendants identical medicinal preparation in the form of tablets bearing the impugned trademark "GLYCIP" which is sold in the packaging which is a complete copy of the plaintiffs packaging for the product GLYCIPHAGE and it also bears identical colour scheme, layout, get-up, letter styles and other features. All this material is a part of the record of this case. As alleged, under the provisions of Section 62 of the Copyright Act, 1957, this Court has jurisdiction to entertain and try the proposed suit for infringement of the copyright. The same facts are also causes of action for infringement of copyright, infringement of trademark and for passing off inasmuch defendants are committing the said acts by use

of infringing trademark and the impugned packaging for their one and the same medicinal preparation GLYCIP.

3. There is no doubt that the cause of action relating to infringement of copyright, infringement of trademark and for passing off action are intricately connected to each other an gives, in a way, a combined cause of action. To prevent multiplicity of proceedings, therefore, such causes can be taken note of in one suit. In the present case, admittedly, the leave was already obtained to combine the cause of action under clause XIV of the Letters Patent.

4. Heard learned counsel appearing for plaintiffs. He has filed an Affidavit of service on defendants. None appeared for defendants.

5. By order dated 8th September, 2003, this Court, after considering the averments made in the Affidavit in support of the Notice of Motion, apart from the averments in the Plaint, granted ad-interim relief in terms of prayer clauses (a), (b) and (c). As observed, none appeared for defendants at the relevant time. None appeared for defendants on 12th September, 2005, and again today i.e. 14th September, 2005.

6. The present suit was filed on 16th June, 2003, immediately after the knowledge and information about use of the trademark viz. "GLYCIP" by defendants. As referred in paragraph 18, the cause of action in the suit arose in April 2003, when the plaintiffs learnt about the use of the impugned trademark and impugned packaging by defendants. In such a suit, the cause of action is always continuous and arises everyday and, as averred, defendants have been continuously marketing and selling its medicinal preparation in question. The plaintiffs have invoked the jurisdiction of this Court, after following due procedure of law by taking leave under Clause XIV of the Letters Patent.

7. A Division Bench of the Bombay High Court in **Sun Pharmaceutical Industries Limited Vs. Wyeth Holdings Corporation and Anr.** - Appeal No.1005 of 2003 in Suit No.2259 of 2003, decided on 14th January, 2004, wherein Appeal arose out of an ad-interim order passed in a Notice of Motion in a suit arising out of a pharmaceutical registered product. The Division Bench, after considering the rival contentions, while dismissing the Appeal, observed thus:

> "38. ..... We cannot overlook, at this stage, the settled law with regard to points like: "registered

> trade mark or proprietary right" "prima-facie effect of registration", prior or long and continuous use", "deceptive or dishonest use" or "deception or confusion" in the mind of "general consumers", "concurrent use or permissible use" and "whole circumstances of the case", specially while granting or refusing or vacating the interim protective order in infringement and or passing off suits. On the contrary, there is sufficient reason to pass such protective order, if above elements, are available and made out on record, at prima-facie stage, and unless these issues are proved otherwise or contradicted in trial, there is no reason to depart from the view taken by the Learned Single Judge.
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> 40. We are of the opinion, that there is common field of activity, common field and procedure for selling such pharmaceutical medicines, and above all "material medica" is common or composition of such product is common, there is more possibility of deception and confusion and infringers action, definitely cause damage to the goodwill and the reputation of the trade mark of parties, like respondents, herein. The factual and actual material including roaring sale in the market and continuous use and marketing of the produce of respondents entitled them to protective or preventive order, against appellants fraudulent or dishonest use of the trade mark i.e. "Parkitane". The equity and the balance of convenience, in such cases, lies in favour of the affected parties and not in favour of the infringers. Appellants plea of acquiescence or publicia juris is devoid of substance, as their own action, is not in good faith and appears to be deceitful. We, therefore, find no justifiable reason to disturb the order of the Learned Judge."

In the present case, the order of ad-interim injunction,

as submitted, has not been carried in Appeal. There is no application for vacation of the ad-interim order in question. The defendants had full knowledge of the proceedings, including the ad-interim order dated 8th September, 2003, as mentioned in the Affidavit of service dated 30th September, 2005, which was communicated in the month of October, 2003, itself.

8. The Trademarks Act 1958 provides the basic foundation for grant of an injunction and/or interim relief if material particulars are placed by the parties on the record alongwith the Affidavit in support of the same. The basic ingredients for grant of ad-interim relief and/or injunction which are made out in the present case are: (i) The plaintiffs are registered owners/proprietors of the trademark in question since 1961 and have been using the same since 1963. The exclusive and extensive marketing and sale of such medicinal products, unobstructively, itself is one of the basic foundation to consider the case of the plaintiffs. (ii) The defendants, apart from not filing any reply or Counter Affidavit to the present averments as raised above admittedly, by adopting phonetically, structurally and visually identical and deceptively similar to the plaintiff’s mark "GLYCIPHAGE" started manufacturing and using the medical product calling it

as "GLYCIP", since April, 2003. The plaintiffs, therefore, without any delay invoked this Court's jurisdiction and prayed for ad-interim injunction. *Prima facie*, therefore, at the relevant time when the Notice of Motion was moved, there was no delay on the part of plaintiffs. (iii) In such suits,

considering the balance of convenience, as well as, the rights which are already in existence in favour of plaintiffs since 1961/1963, the same cannot be disturbed or taken away by any third parties.

9. Even if it takes sometime to grant final relief in such suits, but the parties like plaintiffs cannot be deprived of their right to continue to use the registered trademark exclusively till the decision of the suit. Any obstruction and/or impediment in use of such medicinal products, even otherwise, creates a dilemma and a confusion in the minds of the public at large if other similar trademarks or medicinal products are allowed to be marketed in the same medical market. The observation in **Sun Pharmaceuticals** (supra) also materially support the plaintiff's case.

10. Considering this since averments are made and are supported by Affidavit apart from the material on

the record, I am inclined to confirm the Notice of Motion, as prayed for, in terms of prayer clauses (a), (b) and (c).

9. Notice of Motion is accordingly disposed of.

[ANOOP V. MOHTA, J.]